

REMARKS

I. Status of the Application

At the time of the Action, Claims 1-15 were pending, Claims 16-20 having been withdrawn in response to a restriction requirement. Applicant hereby affirms the election of Claims 1-15. Claim 8 has been canceled above, its subject matter having been incorporated into new Claim 21.

Claim 2 stands rejected as indefinite under Section 112, second paragraph for the inclusion of the term "open to the rear." Applicant submits that this term is definite; it means that the frame includes four uprights and is open both to the front (as recited in Claim 1) and to the rear (as recited in Claim 2). As such, Applicant requests that this rejection be withdrawn. All pending claims stand rejected as obvious under Section 103(a). These rejections are addressed below.

II. The Section 103(a) Rejections

The Action rejects Claims 1-7 and 9-15 as obvious under 35 USC 103(a) over U.S. Patent No. 3,428,245 to Burdett (Burdett) in view of U.S. Patent No. 3,309,160 to Lewis (Lewis) and U.S. Patent No. 4,550,849 to Adsit (Adsit). The Action characterizes Burdett as disclosing a protective frame having a base 12, a plurality of uprights 13, 14 extending from the base, and a roof supported by the uprights, wherein the base, uprights, and roof define a storage cavity. The Action characterizes Burdett as further disclosing a container residing in the storage cavity that is configured to pass through the open front side of the frame. The Action concedes that Burdette fails to disclose a container with sidewalls and an open top end, wherein the sidewalls include engagement locations. Lewis is cited for the disclosure of a container with sidewalls and an open top, and Adsit is cited for the disclosure of a container with sidewalls having engagement locations 22. The Action concludes that it would have been obvious to one of ordinary skill in this art at the time the invention was made to add the open top and sidewall engagement locations of the containers disclosed in Lewis and Adsit to the container system of Burdette so as

to simplify container-emptying processes and facilitate the container removal processes, such as that done by a forklift.

In response, Applicant submits that the Action fails to make a proper *prime facia* rejection of the claims under Section 103(a). More specifically, the rejection is based on the position that the Burdette container would need modification pursuant to the teachings of Lewis (to use a container with an open top and sidewalls) and Adsit (to add engagement locations). If the Burdette container were modified in the manner discussed in the Action (*i.e.*, using a container with an open top and sidewalls and adding engagement locations), the Burdette container would not be operable. The Burdette container system includes a gate 11 upon which a container resides. The presence of the gate 11 would prevent the entry of a forklift into the engagement locations of the container in order to remove it. As such, modification of Burdette in the manner discussed in the Action would not produce an operable container system.

Moreover, Burdette specifically states that the gate 11 has, "around the top and side edges 26 . . . a feather plyable edge to seal the gate against the housing inside wall and top walls for cold climate use." See Burdette at column 2, lines 6-10 (emphasis added). Therefore, omission of the gate (as would be necessary for a combination of the references cited in the Action) would destroy one of the stated purposes of the Burdette container. It is well-established by both the CCPA and the Federal Circuit that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the primary reference, such a proposed modification is not proper and the *prima facie* case of obviousness cannot properly be made. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Such is clearly the case here.

In view of the foregoing, Applicant submits that the Action relies on an improper combination of patents in rejecting the pending claims. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

III. New Claim 21

Applicant has submitted new Claim 21 above for entry and examination. As noted above, new Claim 21 incorporates the subject matter of original Claim 8, which was rejected under Section 103(a) as unpatentable based on the combination of Burdette, Lewis and Adsit discussed above. In addition to the reasons set forth in Section II above, Applicant believes that the subject matter of Claim 21 is independently patentable. In the Action, Claim 8 was rejected as described in Section II, with the additional statement that, despite no mention of the size of the container in Lewis,

[i]t would have been an obvious matter of design choice to design the container to have the aforementioned volume range, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

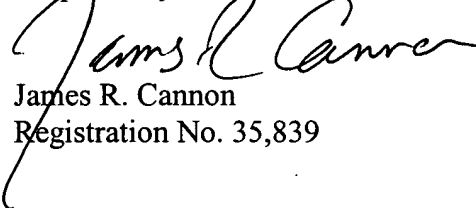
The Lewis container is approximately the size of an ordinary trashcan, which might have a volume of approximately 20 to 55 gallons. This range is far less than even a single cubic yard, and represents a container that an individual could pick up himself and empty. In contrast, Claim 21 recites a container that has a volume of between about four and ten cubic yards, which is at least one and, in some instances, two orders of magnitude larger than the Lewis container. It cannot be picked up and emptied by an individual, but instead requires a commercial refuse collection vehicle with a forklift or the like. Consequently, the design and performance differences between the Lewis container and that recited in Claim 21 would be substantial. The same would be true of the differences in the Burdett "frame", which is sized to house an ordinary trash container, and the recited in Claim 21. As such, Applicant submits that the vast difference in size between the containers of the cited art and that recited in Claim 21 renders *In re Rose* inapplicable to this application, and submits that new Claim 21 is free of the art of record for this additional reason.

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IV. Conclusion

Inasmuch as all of the outstanding issues raised in the Action have been addressed, Applicant respectfully submits that the application is in condition for allowance, and requests that it be passed to allowance and issue.

Respectfully submitted,



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Evelyn Casey

Date of Signature: December 27, 2005